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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/794,154 02/03/97 SCHWARTZ

A SWTZ110464

EXAMINER

QM12/0811

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NERBLIN, P

ART UNIT

PAPER NUMBER

3741

DATE MAILED: 08/11/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/794,154

Applicant(s)
Schwartz et al

Examiner
Peter Nerbun

Group Art Unit
3741



☒ Responsive to communication(s) filed on Jul 30, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 37, 59, and 63 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 37, 59, and 63 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claims 59 and 63 are allowed.

The amendment filed August 2, 1999 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the recitation of a synthetic polymer comprising a block copolymer, including styrene and isoprene, in combination with approximately 70 to 95 weight percent of a stable nonaromatic oil. In this regard note MPEP 608.04(a) which states that: Depending on circumstances such as the adequacy of the original disclosure, the addition of inherent characteristics such as chemical or physical properties, a new structural formula or a new use may be new matter. See *Ex parte Vander Wal*, 109 USPQ 119, 1956 C.D. 11, 705 O.G. 5 (Bd. App. 1955) (physical properties), *Ex parte Fox*, 128 USPQ 157, 1960 C.D. 28, 761 O.G. 906 (Bd. App. 1957) (new formula) and *Ex parte Ayers, et al.*, 108 USPQ 444 (new use). Applicant's original disclosure, on page 6, lines 4-5 states that "Specific information regarding the composition of such material" (viz. Kitecko Ultrasound Standoff Pad 3520 and 3530) "is not available from 3M Corporation". Therefore, the original disclosure provides no indication as to the chemical or physical properties of the Kitecko Ultrasound Standoff Pad 3520 and 3530 and the addition of such properties constitutes new matter. Note that the Board of Patent Appeals and Interferences, on page 10 of the decision dated March 29, 1999, states that "...we have no clear idea as to exactly what composition of gelatinous elastomer is encompassed by "a

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synthetic polymer gel of the type used in the Kitecko Ultrasound Standoff Pad manufactured by 3M Corporation of St. Paul, Minnesota...”.

The declaration of Alvin Zigman, filed January 8, 1997 and re-filed on July 30, 1999 has been fully considered. Dr. Zigman defines the chemical and physical properties of Kitecko Ultrasound Standoff Pad 3520 and 3530 in the following manner: “a synthetic polymer-oil elastomeric combination comprised of 10-12 weight percent of A-B-A type unvulcanized elastomeric block copolymer in paraffin oil wherein each A block is a glassy resinous, nonelastomeric thermoplastic polymer block with a glass transition temperature above room temperature and having an average molecular weight of approximately 12,000 to 17,000, the end blocks A of the block copolymer constituting approximately 20 percent of the total polymer weight which is styrene and the B block is an elastomeric polymer block of a conjugated diene having an average molecular weight of approximately 80,000 to 110,000, and having a glass transition temperature below that of the A block and is comprised of isoprene; and 70-95 weight percent of a stable nonaromatic paraffin oil of low volatility and having a boiling point in excess of the melting temperature of the elastomeric block polymer.”. None of these properties was disclosed in the original disclosure of the parent application SN 08/377,257, filed January 23, 1995. These properties may not be introduced into the claim language of the instant application merely because they are set forth in a declaration filed at a time subsequent to the filing date of the parent application. Again referring to page 10 of the decision of the Board of Patent Appeals and Interferences, dated March 29, 1999, the examiner takes note of the

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Board's comment that "...we have no clear idea as to exactly what composition of gelatinous elastomer is encompassed by "a synthetic polymer gel of the type used in the Kitecko Ultrasound Standoff Pad manufactured by 3M Corporation of St. Paul, Minnesota...". Note that the Board had full view of the abovementioned declaration of Dr. Zigman prior to making this statement since the declaration was made on January 8, 1997 and the Board decision was mailed on March 29, 1999.

Applicant is required to cancel the new matter in the reply to this Office action.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). As noted above the claim language recites a synthetic polymer comprising a block copolymer, including styrene and isoprene, in combination with approximately 70 to 95 weight percent of a stable nonaromatic oil. At no point does the specification define a synthetic polymer having these specific chemical and physical properties.

Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim language recites a synthetic polymer comprising a block copolymer, including styrene and isoprene, in combination with approximately 70 to 95 weight percent of a stable nonaromatic oil. These specific chemical and physical properties of a synthetic polymer were not described in the specification in such a way as to reasonably convey to

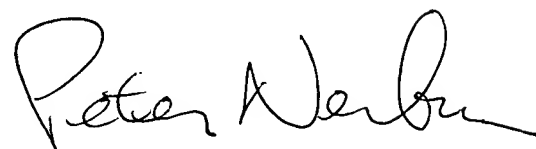
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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Indeed applicants acknowledges in the specification that specific information regarding the composition of such material" (viz. Kitecko Ultrasound Standoff Pad 3520 and 3530) was not available from 3M Corporation (See page 6, lines 4-5 of the specification.).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Nerbun, whose telephone number is (703)-308-0955. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00. The examiner also can be reached on alternate Fridays.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-308-0861.

Peter Nerbun
August 10, 1999

A handwritten signature in black ink, appearing to read "Peter Nerbun", with a stylized, cursive script.

Peter Nerbun
Primary Examiner